

## II. REMARKS

Claims 56 to 89 are pending in the subject application and stand variously rejected by the Office in the outstanding Office Action. By this Amendment and Response, claims 56 to 59, 62 and 76 have been amended.

These amendments are made without prejudice or disclaimer and are not intended to be a dedication to the public the subject matter of the claims or their equivalents, as filed or previously amended. Applicants reserve the right to pursue the claims as originally filed and preliminarily amended in a later filed continuation application.

Support for the amendments to the claims can be found in the specification as originally filed. For example, support for the amendments to claims 56, 57 and 58 are found in the application papers on page 31, lines 5-8; page 32, lines 5-6 and 18-33 and page 34, lines 11-28. Claim 59 is amended herein to correct a grammatical error. Claims 62 and 76 are amended herein to correct a typographical error pointed out by the Office, i.e.,  $-\text{CH}_3$  has been substituted for a terminal  $-\text{CH}_2-$  group. An issue of new matter is not raised by these amendments and entry thereof is respectfully requested.

In view of the preceding amendments and remarks that follow, reconsideration and withdrawal of the objections to the specification and the rejections of the claims are respectfully requested.

Amended claims 56 to 89 are currently under examination.

### 35 U.S.C. § 112, First Paragraph

Claim 85 stands rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office stated that reference in claim 85 is made to assays using compounds which have been disclosed generically or subgenerically. The Office alleged that this reference to compounds is excessively broad in light of the disclosure wherein only selected compounds have been tested.

Claims 56 and 57 and separately claims 56-61, 81-84 and 86-89, stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office alleged that these claims refer to methods of treatment using compounds which have been disclosed generically or subgenerically. The Office opined that this is excessively broad in light of the disclosure wherein only selected compounds have been tested and as to the types of cancer which can be treated; no data is provided to show effective treatment of liver cancer.

Claims 62-80 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office alleged that in claims 62-80 reference is made to compounds which have been claimed generically and subgenerically. The Office opined that this is excessively broad in light of the disclosure wherein only selected compounds have been actually synthesized.

Applicants respectfully traverse, with respect to all claims rejected under 35 U.S.C. § 112, first paragraph and on all grounds for rejection.

Applicants reiterate that the Office Action does not provide any evidence the above-referenced teachings, in combination with what was known to those skilled in the art, does not enable the full scope of the claims. However, in order to advance prosecution but without conceding the correctness of the Examiner's position, the claims have been amended in a sincere effort to overcome the grounds for rejection. Accordingly, removal of the rejections under 35 U.S.C. § 112, first paragraph is respectfully requested.

#### Claim Objections

The Office objected to claim 62, on the ground that punctuation marks (commas) separating the members of the Markush Group defining variable R<sup>4</sup> are missing.

The Office also objected to claims 62 and 76, on the ground that the structure of the defined substituent includes a terminal CH<sub>2</sub> group which appears to represent a valence error.

Applicants have corrected claims 62 and 76 to correct typographical and grammatical errors as requested by the Office. In view of these amendments, reconsideration and removal of the objections to claims 62 and 76 is respectfully requested.

35 U.S.C. § 112, Second Paragraph

Claims 56-59, 61-63, 65, 72 and 81-87 remain rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In claim 57, the Office alleged that the term "hyperproliferative cells" is indefinite for failure to specify the particular disease being referred to. The Office further alleged that the term "pathological cell" fails to define the disease in claims 56, 58, 81-84, 86 and 87.

The Office further stated that in claim 58, the terms "a sugar substituent," "a thio sugar substituent," "a carbasugar substituent," and "a seco-sugar substituent" are allegedly indefinite because they fail to detail structure.

The Office also argued that in claim 59, the term "masked phosphoryl moiety and phosphoramidatyl moiety" are indefinite.

The Office remarked Applicants' argument that the Office has not provided any evidence that the noted terms are not well known in the art or that the terms would not be understood by the ordinary practitioner upon inspection of the disclosure, unpersuasive. The Office respectfully disagreed and referred Applicants to the amended grounds of rejection which point out with particular examples the problem of indefiniteness caused by the noted term in its previous and its present iterations.

With respect to in claim 58, the Office further noted that the terms "an electrophilic leaving group" (line 4), "a phosphoryl or phosphoramidatyl" (line 6), and "masked phosphoryl," (line 9) are allegedly incomplete for failure to completely specify the chemical structures being claimed, which also makes searching of the claimed subject matter in its entirety impossible.

The Office also stated that in claim 62, at lines 10-11, the term "aromatic hydrocarbyl group" does not consist of "one or more unsaturated hydrocarbyl groups," although this may appear to be the case, and that similarly at lines 11-12 a heteroaromatic group (2-, 3-, or 4-pyridinyl radical?) is not correctly defined as consisting of "one or more unsaturated hydrocarbyl groups," wherein no heteroatoms are provided for.

Applicants respectfully traverse. The claims have been amended herein in a sincere effort to address and overcome many of the grounds for rejection of the claims under 35 U.S.C. § 112, second paragraph. Moreover, Applicants note that the claims employ language conventionally used in the art to which the invention pertains and therefore adequately define the metes and bounds of the claimed invention. *See, e.g., In re Miller*, 441 F.2d 689, 692-93, 169 U.S.P.Q. 597, 599 (C.C.P.A. 1971); *In re Kamal*, 398 F.2d 867, 870, 158 U.S.P.Q. 320, 322 (C.C.P.A. 1968).

In view of the preceding amendments and remarks, reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. § 112, second paragraph, is respectfully requested.

#### Provisional Double Patenting Rejections

Claims 56-61, 81-84 and 86-89 remain rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-12 of U.S. Patent No. 6,495,553.

Claim 62-80 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-39 of U.S. Patent No. 6,339,151.

Claims 56-84 and 86-89 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,245,750 and claims 1-30 of co-pending application Serial No. 10/119,927.

Applicants respectfully defer responding to the objections until allowable subject matter is indicated in this application.

Supplemental IDS

Attached to the response filed November 5, 2003 was a Supplemental IDS for consideration and entry into the application file.

**III. CONCLUSION**

No fee is deemed necessary in connection with the filing of this Supplemental Amendment and Response. However, if the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 50-2518**, referencing billing number **2023896-7008263002**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account. Should a telephone advance prosecution of the subject application, the Examiner is invited to contact the undersigned at (650) 849-4950.

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Respectfully submitted,

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